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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/331,729	08/26/1999	FRANK OSAN	514425-3732	2014

23416 7590 04/02/2003

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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

24

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.
Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
 - (b) ☒ they raise the issue of new matter. (see NOTE below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

See attached, paragraph 1

4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached, paragraph 2
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: 53
Claim(s) objected to: _____
Claim(s) rejected: 35-52, 54-57
Claim(s) withdrawn from consideration: _____
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☒ Other: attached

James L. Dote
PRIMARY EXAMINER

1. The proposed amendments to claims 35, 39, 40, 42, 48, 49, and 55 filed after the final rejection in Paper No. 23 on Mar. 24, 2003, raise new issues and the issue of new matter.

For example, the amendments to claims 35 and 49, deleting the limitation that the first resin or the first resin fraction has a glass transition temperature Tg of lower than 70°C, raise new issues because the proposed amended claims do not require that the first resin or resin fraction have a Tg lower than 70°C, as previously required by claims 35 and 49.

The amendments to claims 35, 39, 40, 48, 49, and 55 add limitations that were not present in those claims at the time the final rejection was mailed.

The amendment to claim 48 also raises a rejection under 35 U.S.C. 112, second paragraph, because it is not clear how a resin fraction having a "Mn of 25,000 or more" is part of a second resin or resin fraction having a Mn of "7,500 or more but less than 25,000."

The amendment to claim 42 raises a rejection under 35 U.S.C. 112, first, for new matter. The originally filed specification does not disclose a polyolefin "crosslinked by . . . [an] ester, amide, sulfide or ether wherein the crosslinked structure is obtained by the reaction of (a) a diene monomer with (b) an acyclic olefin and (c) a cycloolefin" as recited in proposed amended claim 42. Rather, the originally filed specification at

page 13, lines 3-10, discloses a crosslinked polyolefin resin having a cyclic structure obtained by reacting a diene monomer, such as norboradiene or cyclohexadiene, together with an acyclic olefin monomer and a cycloolefin monomer. The specification does not disclose that the disclosed reaction product is crosslinked by an ester, amide, sulfide, or ether as recited in the proposed amended claim 42.

The amendment to claim 42 also raises a rejection under 35 U.S.C. 112, second paragraph, because it is not clear how the reaction product produces a structure crosslinked with an ester, amide, sulfide, or an ether, when the reactants (a) through (c) do not contain an ester, amide, sulfide, or ether forming group.

In addition, the replacement paragraphs at page 17 of the specification filed in Paper No. 23 attempt to amend paragraphs that are not present in the instant specification. The paragraphs at page 17 of the specification were previously amended in Paper No. 7 filed on Dec. 12, 2000. The amendment in Paper No. 7 capitalized the trademarks ISOPAR H[®] and REFLEX BLUE[®] R51. Both the marked-up and clean copies of the replacement paragraphs filed in Paper No. 23 do not disclose said capitalized terms.

2. The examiner's refusal to enter the amendment filed after the final rejection in Paper No. 23 renders moot applicants' arguments regarding said amendment.

In addition, applicants' arguments in Paper No. 23 that the toners in examples 20-30 and comparative examples 5 and 6 are made by Toner preparation method 5 are not persuasive. Contrary to applicants' statements, Toner preparation method 4 does not make a precursor of a toner without a charge control agent and a colorant. Toner preparation method 4 discloses mixing toner "obtained with the formulation of the dry polymerized system" and ISOPAR H. The dry polymerized system is described in Toner preparation method 3, which makes toner particles comprising 1 wt% of the charge controlling agent, COPY CHARGE NX, and 5 wt% of a magenta pigment.

Applicants' arguments regarding the 35 U.S.C. 112, first paragraph, rejection of claim 36 in Paper No. 23 are not persuasive for the reasons set forth in the final rejection in Paper No. 22 mailed on Dec. 19, 2002, paragraph 9, item (2). Contrary to applicants' statements, the rejection is not with respect to the term "hybrid mixtures," but to the broadly recited term "hybrid polymers." The rejection of claim 36 stands for the reasons of record.

Applicants' arguments with respect to the rejections of claims 49-52, 54, and 57 over WO'529 in Paper No. 23 are not

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Art Unit: 1756

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persuasive because the amendment filed after the final rejection in Paper No. 23 has not been entered. Applicants have not perfected their claim to foreign priority under 35 U.S.C. 119 for the reasons discussed in the final rejection, Paper No. 22, paragraph 14.